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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,688	03/01/2004	Jeffrey Bergh	HARD1.072A	2600
60148	7590	07/14/2006		EXAMINER
GARDERE / JAMES HARDIE				KENNEDY, JOSHUA T
GARDERE WYNNE SEWELL, LLP				
1601 ELM STREET			ART UNIT	PAPER NUMBER
SUITE 3000				3679
DALLAS, TX 75201				

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/791,688	BERGH ET AL.	
	Examiner	Art Unit	JTK
	Joshua T. Kennedy	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 May 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7,9-19,25-45 and 68-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7,9-19,25-45 and 68-78 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/10/2006 has been entered.

Claims 1-7, 9-19, 25-45, and 68-78 have been examined.

Claim 8 has been cancelled.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-19, 25-45, and 68-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newberry, Jr. (US 3,801,072) in view of Gleeson et al (US Patent Application Publication 2001/0047741).

As to Claims 1-4, 9-12, 15-17, 25, 26, 31, 34-36, 42, 68, 70, and 72. Newberry, Jr.

discloses a fence system, comprising:

a mounting surface (20,30); and

a plurality of individual elongate members or pickets (11) attached to the mounting surface, wherein each individual member has an upper end, a lower end, a front surface, a back surface and a pair or sides adjoining the front surface and back surface, and wherein the plurality of individual members are made into a desired shape for use in the fence system prior to curing (Col 1, Lines 35-43),

a plurality of individual fasteners (Col 4, Lines 27-30) for attaching the plurality of individual members (Fig 5) to the mounting surface (20,30), wherein each individual fastener passes through the front surface and the back surface of the individual member (Col 4, Lines 27-30), and

the plurality of individual members having at least one surface that has a pre-finish thereon resembling a wooden picket (Col 1, Lines 29-43); said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1; Col 3, Lines 61-64).

Newberry Jr. does not disclose the plurality of individual members made of fiber cement whereby the plurality of individual members do not exhibit any substantial fraying of the fibers along surfaces of the plurality of individual members after curing. Wherein the fiber cement forming the plurality of individual members incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the plurality of individual members as taught by Newberry to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

As to Claims 5, 19, 69, and 75. Newberry Jr. discloses the upper end of at least one individual member being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1— Shows the pickets with a dog-eared shape).

As to Claims 6, 7, 27, 32 and 76-78. Newberry Jr. discloses the front surface and back surface of at least one individual member having a first surface, wherein the first surface

has a finish that is capable of resembling wood or the color thereof or masonry (Col 1, Lines 39-43).

As to Claim 28. Newberry Jr. discloses the at least one surface comprising two opposing sides of the individual member (Col 3, Lines 45-58).

As to Claims 13, 14, 43, and 44. Newberry Jr. discloses the mounting surface comprising a pair of mounting rails (20) having a longitudinal axis, and the at least one individual member is positioned in a manner such that a longitudinal axis of the individual members (or pickets) is substantially perpendicular to the longitudinal axis of the mounting surface, wherein a first mounting rail is secured to the pickets at an upper location of the pickets, and a second mounting rail is secured to the pickets along a lower location of the pickets (Fig 4).

As to Claim 18. Newberry Jr. discloses the at least one individual member having at least one surface that is embossed with a pattern (Col 1, Lines 39-43).

As to Claims 29 and 30. Newberry Jr. discloses at least one exterior surface of the picket being stained or being textured (Col 1, Lines 39-43).

As to Claim 33. Newberry Jr. discloses the picket capable of being nailed onto a fence rail (Col 4, Lines 27-30).

As to Claims 39, 71, and 73. Newberry Jr. discloses a fence system wherein each of said pickets has a length between about 6 and 8 feet (Col 2, Lines 5-7).

As to Claim 45. Newberry Jr. discloses at least two posts, each of said posts having an elongate configuration extending between an upper end and a lower end and being substantially parallel to the pickets, said posts being secured to the mounting rails, wherein the lower ends of the posts extend below the lower ends of the pickets to secure the posts in a ground location (Fig 4; Col 4, Lines 13-15).

As to Claims 37 and 38. Newberry Jr. does not disclose a fence system wherein each of said pickets has an aspect ratio of between 4 and 12 and is spaced from one another by a distance of between about 1/2 and 1 inch. However, it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have an aspect ratio of between 4 and 12 and be spaced from one another by a distance of between about 1/2 and 1 inch so as to achieve the desired aesthetic appearance.

As to Claims 40 and 74. Newberry Jr. does not disclose a fence system wherein each of said pickets has a width between about 4 and 12 inches. However, it is not inventive to state the optimum or workable values of the size of the pickets. As determined

through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a width between about 4 and 12 inches so as to achieve the desired aesthetic appearance.

As to Claim 41. Newberry Jr. does not disclose a fence system wherein each of said pickets has a thickness of between about 5/16 and 3/4 inch. However, it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a thickness of between about 5/16 and 3/4 inch so as to achieve the desired aesthetic appearance.

#### ***Response to Arguments***

Applicant's arguments filed 5/10/2006 have been fully considered but they are not persuasive.

As to Claims 1, 15, 25, 34, 68, and 72, Applicant argues that:

*Neither Newberry or Gleeson, taken individually or in combination, teaches or makes obvious a fence system containing a mounting surface and a plurality of individual members attached to the mounting surface... [nor] a plurality of individual fasteners for attaching the plurality of individual members to the mounting surface.*

Examiner respectfully disagrees as to Claims 1, 15, 25, 34, 68, and 72, because, as advanced above, Examiner considers one of the members of Newberry to be one of a plurality of individual members (as seen in Fig 5) and that each of these members is mounted to a mounting surface (20,30) via the use of a fastener (such as nails). Each of the members of Newberry has upper and lower ends, front and back surfaces, and sides to adjoin those surfaces. Further, it is also noted that a one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965).

Applicant additionally argues that:

*Gleeson does not disclose or suggest a fiber cement material for use in a fence system as presently claimed...and are made into a desired shape prior to curing and which does not exhibit any substantial fraying of the fibers on the surfaces after curing.... Although Gleeson discloses that fiber cements may be applicable to fencing applications, this would not be interpreted to include fences which have a partially decorative function by one of ordinary skill in the art.*

Examiner respectfully disagrees as to Claims 1, 15, 25, 34, 68, and 72, because Newberry Jr. discloses that the fence panel is made into a desired shape prior to curing (Col 2, Lines 11-21 and 41-58) and it is well known within the art to ensure a member

has cured properly, whether it is fiberglass or fiber cement, hence is not exhibiting fraying of any fibers and there is no delamination after the curing has occurred. It is also noted that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitation "which is made into a desired shape prior to curing and which does not exhibit any substantial fraying of the fibers on the surface or visible separation of the layers... after curing" has been given only limited patentable weight. See MPEP § 2113.

As advanced above, the fiber cement as taught by Gleeson et al would be used in combination with the molding process of Newberry Jr. The fiber cement members are capable of being molded (Gleeson et al, Paragraph 35, Line 1) to the desired shape of the fence, meaning no cutting of cured fiber cements is needed. Thus, it would not exhibit any delamination, fraying, or other damage, which comes as a result of cutting.

Applicant additionally argues that:

*"the references do not teach or suggest a fence system comprising a horizontal mounting surface, and a plurality of individual members attached to the mounting surface"*

Examiner respectfully disagrees and points out that Applicant never claims the mounting surface to be horizontal. Even if Applicant did claim the mounting surface as such, Examiner considers the mounting surface of Newberry to comprise the post and

horizontal bars. Thus providing a mounting surface for a plurality of members to be attached by a fastener, such as a nail (Col 4, Lines 27-30).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTK  
6/28/2006



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